

REMARKS

Applicants have carefully reviewed the Application in light of the Office Action mailed February 12, 2004. At the time of the Office Action, Claims 1, 4-11, 13-18, 20-21, and 24-29 were pending in the present application. The Examiner rejects Claims 1, 4-11, 13-18, 20-21, and 24-29. Claim 8 has been cancelled. New Claim 30 has been added. For the reasons set forth below, Applicants believe that all pending claims are allowable over the cited references.

Submission of Information Disclosure Statement (IDS)

Applicants submit an IDS with this Response for the Examiner's review and consideration. Applicants respectfully request that the Examiner formally indicate that the references were considered in the prosecution of the Application.

Rejections Under §103

The Examiner rejects Claims 1, 4-5, 7-11, 13, 15-18, 20-21, 24-25, and 27-29 under 35 U.S.C. §103(a) as being obvious over U.S. Patent 6,449,269 issued to Edholm ("*Edholm*") in view of U.S. Patent No. 6,321,336 issued to Applegate, et al. ("*Applegate*"). In addition, the Examiner rejects Claims 6, 14, and 26 under 35 U.S.C. 103(a) as being obvious over *Edholm* in view of *Applegate*, and further in view of U.S. Patent No. 5,896,379 issued to Haber ("*Haber*").

Edholm recites a connectionless base protocol that is leveraged to transfer streaming voice to a destination telephony device. (*Edholm*, Abstract). An IP telephone is provided having a controller and memory to specify a destination IP address. (*Edholm*, Col. 2, Lines 33-35). The IP telephone also includes a packetizer connected to the controller to packetize outbound voice signals. (*Edholm*, Col. 2, Lines 35-39). The system includes a phone server that receives control information and acts as an intermediary that is transparent to the destination telephony device. (*Edholm*, Col. 3, Lines 18-28).

Applegate discloses a firewall to protect communications between an internal network and an external network. (*Applegate*, Col. 2, Lines 9-11). The firewall filters out unacceptable protocols originating from the external network. (*Applegate*, Col. 4, Lines 34-35). The firewall also hides the identities of internal computers from the external network via network address translations. (*Applegate*, Col. 4, Lines 37-39).

In order to establish a prima facie case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations.¹

No Suggestion, Teaching, or Motivation to Combine References

In the present case, a prima facie case of obviousness cannot be maintained for at least Claims 1, 10, 18, and 21 and new Claim 30 because neither *Edholm*, *Applegate*, nor *Haber* provide a suggestion, teaching, or motivation to a person of skill in the art to combine the references to achieve the present invention. *Edholm* discloses data processing in the context of facilitating improved communication between telephony devices. However, *Edholm* does not disclose the use of its invention for security purposes, nor does the reference disclose the need to perform address translations. *Applegate* discloses address translations on communications between FTP servers for the purposes of protecting internal networks from external networks. However, *Applegate* does not disclose manipulating telecommunications data or the need for such manipulation, nor does *Applegate* teach or suggest the use of its firewall between telephony devices.

Furthermore, the M.P.E.P. and Federal Circuit case law support Applicants' position that a combination of references is improper in this case. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.² The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art" at the time of the

¹ M.P.E.P. § 2143.

² See *Carella v. Starlight Archery*, 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986).

invention.³ The “fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification.⁴

The governing Federal Circuit case law makes this strict legal standard even clearer.⁵ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding.”⁶ “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.”⁷ However, the “range of sources available . . . does not diminish the requirement for actual evidence.”⁸ In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.⁹

Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed combination is not sufficient to establish

³ M.P.E.P. 2143.01.

⁴ *Id.* (emphasis in original).

⁵ Note M.P.E.P. § 2145(X)(C) (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

⁶ *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)).

⁷ *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

⁸ *Id.*

⁹ *Id.* (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted); see also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.).

obviousness.¹⁰ In the present case, the Examiner has merely stated that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have provided Edholm with a virtual intermediary that provides source address translation, in light of the teachings of Applegate, et al., in order to provide a means of securing the connection between the end users of the telephony devices in Edholm." (Office Action mailed 2/12/04, Page 3). However, speculation in hindsight that "it would have been obvious" to make the proposed combination because the proposed combination would supposedly be helpful is insufficient under the M.P.E.P.¹¹ and governing Federal Circuit case law.¹² In the present case, the Examiner is improperly using the Applicants' disclosure as a blueprint for piecing together various elements of *Edholm* and *Applegate* to achieve the Applicants' invention.

Furthermore, if the Examiner is relying on "common knowledge" or "well known" art to combine references, the Examiner should provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relied on personal knowledge to supply the required motivation or suggestion to combine the references, the Examiner should provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

For at least the reasons discussed above, a prima facie case of obviousness cannot be maintained for Claims 1, 10, 18, and 21 and new Claim 30 because the cited references fail to teach, suggest, or motivate a person of skill in the art to combine the references as proposed by the Examiner. Therefore, Applicants respectfully request reconsideration and allowance of Claims 1, 10, 18, 21, and 30, as well as all claims that depend from these claims.

¹⁰ See *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

¹¹ See M.P.E.P. § 2145(X)(C) ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.")

¹² For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been met motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].").

The Cited References Fail to Disclose, Teach, Or Suggest All Elements of Claims 7, 15-16, 27-28, and 30

In addition to the reasons discussed above, a prima facie case of obviousness cannot be maintained for Claims 7, 15-16, 27-28, and 30 because the cited references fail to disclose, teach, or suggest each and every element of those claims. For example, Claim 7 recites that "manipulating the telecommunication data received from the first telephony device comprises converting the telecommunication data from a first data format compatible with the first telephony device to a second data format compatible with the second telephony device." Claims 15 and 27 recite similar, although not identical, limitations. The Examiner states that *Edholm* discloses this limitation. (Office Action mailed 2/12/04, Page 3, citing *Edholm*, Col. 11, Lines 20+). *Edholm* merely discloses converting between different layer IP protocols so that communication devices using different layer IP protocols may communicate with one another even if the devices are unable to process the packet control information internally. (*Edholm*, Col. 3, Lines 8-12; Col. 11, Line 56 – Col. 12, Line 12). However, converting between different layer IP protocols, as disclosed in *Edholm*, is distinctly different from converting telecommunications data between *data formats*, as recited in Claims 7, 15, and 27. For example, the data conversions disclosed in the present application may include, but are not limited to, conversions between: (1) a first audio encoding format and a second audio encoding format; (2) a first data compression format and a second data compression format; and (3) a first signaling protocol and a second signaling protocol. Furthermore, the Examiner fails to point out any portion of *Applegate* or *Haber* that discloses, teaches, or suggests converting telecommunication data from a first data format compatible with the first telephony device to a second data format compatible with the second telephony device.

For at least this additional reason, a prima facie case of obviousness cannot be maintained for Claims 7, 15, and 27. For similar reasons, a prima facie case of obviousness cannot be maintained for new Claim 30. Therefore, Applicants respectfully request reconsideration and allowance of 7, 15, 27, and 30, as well as Claims 16 and 28, which depend from Claims 15 and 27.

CONCLUSION

Applicants have made an earnest attempt to place this application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Applicants submit herewith a check in the amount of \$180.00 to cover the cost of the IDS filing fee. Applicants also submit a check in the amount of \$86.00 to cover the cost of the addition of one (1) independent claim. The Commissioner is hereby authorized to charge additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

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